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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,972	01/16/2004	James Stoffer	423.027US1	6512

7590 07/22/2009  
Schwegman, Lundberg, Woessner & Kluth, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402

EXAMINER
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NERANGIS, VICKEY MARIE

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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07/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,972	<b>Applicant(s)</b> STOFFER ET AL.	
	<b>Examiner</b> VICKEY NERANGIS	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 23-29, 154-159, 162 and 163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 22 and 191 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/30/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1-8,10-14,16-31,35,39-59,61,62,67,68,70,121,122,132,133,139,141,143-145,147-151,154-166,168,184,186,187 and 191.

Continuation of Disposition of Claims: Claims rejected are 1-8,10-14,16-21,30,31,35,39-59,61,62,67,68,70,121,122,132,133,139,141,143-145,147-151,160,161,164-166,168,184,186 and 187.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/30/2009 has been entered.
2. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 4/30/2009.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

### ***Examiner Interview***

4. No examiner interview was had because of time constraints. Applicant is, as always, invited to contact the examiner upon receipt of this Office action.

### ***Claim Objections***

5. Claims 10 and 11 are objected to because of the following reasons:

With respect to claim 10, the term "compound" should be replaced with --oxide-- because claim 1 only includes praseodymium oxides.

With respect to claim 11, it is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

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required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Appropriate correction is required.

6. Applicant is advised that should claim 42 be found allowable, claim 70 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

7. Claims 1-8, 10-14, 16-21, 30, 31, 56-59, 61, 62, 67, 68, 139, 141, 143-145, 149, 150, 164-166, 168, and 184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung et al (WO 02/31064).

It is noted that the international Patent Application WO publication is being utilized for date purposes. However, since WO 02/31064 is in German, in the discussion below, the US equivalent for WO 02/31064, namely US 2004/0062873 is referred to in the body of the rejection below. All column and line citations are to the US equivalent.

Jung et al discloses an aqueous (paragraph 0011) paintlike polymer-containing, corrosion-resistant layer comprising 5-90 wt % inorganic compound such as rare earth oxide(s) and at least one other rare earth compound and/or BaSO<sub>4</sub> (i.e., extender) or TiO<sub>2</sub> (paragraph 0099); a rare earth salt (paragraph 00135); a pigment such as talc (paragraph 0026), and dispersant (examples). The other rare earth compound includes salts of rare earth metals like

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sulfate (paragraph 0042). The polymers used include any of those listed in paragraph 00107, e.g., epoxies and silicones.

Jung et al fails to (i) explicitly disclose the addition of praseodymium oxides, (ii) to disclose the oxidation states of praseodymium oxide, (iii) to explicitly disclose the use of mixtures of rare earth oxides, and (iv) the relative amounts of rare earth compound and substantially insoluble extender.

With respect to (i), Jung et al teaches the addition of rare earth oxide. Praseodymium is a type of rare earth metal. Therefore, given the finite list of rare earth metals, it would have been obvious to one of ordinary skill in the art to utilize praseodymium oxides as the rare earth oxide of Jung et al.

With respect to (ii), given that the rare earth metal praseodymium has a limited number of oxidation states, it would have been obvious to one of ordinary skill in the art to utilize any one of the oxidation states of praseodymium in order to impart corrosion resistant properties.

With respect to (iii), Jung et al teaches the use of rare earth oxide(s) which suggests that more than one rare earth oxides can be used. Therefore, it would have been obvious to one of ordinary skill in the art to utilize more than one rare earth oxide. Furthermore, case law holds that it is prima facie obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F,2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

With respect to (iv), given that Jung et al teaches mixtures of the rare earth compounds and sulfates, it would have been obvious to one of ordinary skill in the art to utilize a 1:1 mixture, which would read on the presently claimed amounts. When faced with a mixture, one of ordinary skill in the art would be motivated by common sense to select a 1:1 ratio, a ratio that

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falls within the presently claimed amount, absent evidence of unexpected or surprising results. Case law holds that “[h]aving established that this knowledge was in the art, the examiner could then properly rely... on a conclusion of obviousness, 'from common knowledge and common sense of the person of ordinary skill in the art within any specific hint or suggestion in a particular reference.'" *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

8. Claims 35, 39-55, 70, 121, 122, 132, 133, 147, 148, 151, 160, 161, 186, and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung et al (WO 02/31064) in view of Reuter et al (US 2003/0082368).

The discussion with respect to Jung et al in paragraph 7 above is incorporated here by reference.

Jung et al does not disclose the use of calcium sulfate but teaches the use of additional inorganic compounds such as calcium and sulfate salts (paragraph 0043) and BaSO<sub>4</sub> (paragraph 0099).

Reuter et al discloses an aqueous coating material and teaches that typical anticorrosion pigments include calcium sulfate, barium sulfate, etc (paragraph 0069).

Given that Jung et al teaches the use of calcium and sulfate salts and further given the teaching by Reuter et al regarding that calcium sulfate is a typical and well known anticorrosion pigment, it would have been obvious to one of ordinary skill in the art to utilize a calcium sulfate in the anti-corrosive paint composition of Jung et al, wherein calcium sulfate is hydrous or anhydrous given that those are the only two possible options.

***Double Patenting***

9. Claims 1-7, 15, 17, 35, 42-45, 70, and 151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 10/758,973 (published as US 2004/0186201).

The rejection is adequately set forth in paragraph 13 of Office action mailed on 6/9/2008 and is incorporated here by reference.

10. Applicant's statement on page 16 of the amendment filed 9/24/2008 regarding the provisional obviousness-type double patenting rejection is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

***Allowable Subject Matter***

11. Claims 22 and 191 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments filed 4/30/2009 have been fully considered but they are not persuasive. Specifically, applicant argues that applicant has established unexpected results and long felt need of the claimed invention;



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In response, while the data is shown for preferred embodiments of the invention, such is not persuasive given that the data is not reasonably commensurate in scope with the scope of the invention.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701.

The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/17/2009

vn

/Vickey Nerangis/  
Examiner, Art Unit 1796